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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PATS, JUSTIN	

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,542	JESSUP ET AL.	
	Examiner	Art Unit	
	Justin M. Pats	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,8-10,12,13,15-17 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,8-10,12,13,15-17 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/22/09 has been entered, in which Applicant amended claims 1, 8, and 15. Claims 1–3, 5–6, 8–10, 12–13, 15–17, and 20 are pending in this application and have been rejected below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1–3, 5–6, 8–10, 12–13, 15–17, and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In independent claims 1, 8, and 15, Applicant includes the phrase—representing the impact of the respective root cause of trouble on the project development effort, and then uses this factor in a graphical plot against strength of analysis. However, it is unclear from the claim recitation as to the differentiation between impact and strength of analysis because one could interpret strength of analysis as representing impact, however, these two variables are seemingly not equivalent given Applicant's recitation of a graphical plot which compares the two variables against one another. As such, Examiner requests that Applicant clarify the impact variable at least as to how, if at all, it is calculated differently from strength of analysis, and separate the two variables' recitation via indentation to make their nonequivalence clear. For purposes of examination, Examiner will assume impact and strength of analysis as distinct variables which are not equivalent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1–3, 5–6, 8–10, 12–13, 15–17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitacre et al., U.S. Pat. Pub. No. 2004/0138944 [hereinafter Whitacre], also evidenced by Whitacre et al., Provisional Application, 7/22/02, pg. 1–76 [hereinafter Provisional] in view of Miller, U.S. Pat. Pub. No. 2002/0165752 further in view of Applicant's Admitted Prior Art, further in view of Nelson, U.S. Pat. 7,451,063.

7. As per claim 1, Whitacre teaches a method of assessing an effort comprising: identifying multiple possible root causes of trouble for an effort (Whitacre, ¶ 0086); identifying multiple questions sets for the multiple possible root causes of trouble, each question set being a comprehensive set of questions directed to diagnosing a respective root cause of trouble of the multiple possible root causes of trouble, and thus assessing the effort (Whitacre, ¶ 0087–88; Provisional, pg. 64–74, especially pg. 66–68, Root Cause Analysis Chart, which lays out a plurality of question sets for different potential root causes for diagnostic purposes—for example, the question set on pg. 67, **1) Has a team member received feedback that indicated the performance is less than satisfactory?**, and **2) Will the team member be surprised that his/her performance is less than satisfactory?** are directed to diagnosing **Whether or not the**

team member knows that the performance is less than satisfactory, which is one of the multiple possible root causes of the problem because if someone does not know there is a problem, they will be inclined to alter or change their ways in order to fix the problem. Further demonstrating this teaching of Whitacre is the question set on pg. 67, **1) Does the Team Member lack the authority, time or tools?**, **2) Are there conflicting demands on the Team Member's time?**, and **3) Are there outdated or unruly restrictive policies in place?)**, which is directed to diagnosing **Whether there are obstacles beyond the Team Member's control**, which is one of the multiple possible root causes of the problem because if there is an obstacle that is out of one's control, they will likely be unable to remedy that situation) and identifying specific project role(s) to provide responses to questions of the question set, the responses from the specific project role(s) facilitating diagnosing the respective root cause of trouble (Provisional, pg. 67–68, identifying **team members'** actions and circumstances dictating the question sets, associate responses, and corrective action); evaluating answers to the question sets and provide guidance based on the scored questions regarding existence of one or more root causes of trouble for the effort from the identified multiple possible root causes of trouble (Whitacre, ¶ 0086, "The following is a list of tools that can help determine the root cause: Brainstorming, Cause and effect analysis (fishbone diagram), Histogram, Graphs, Pareto diagrams, and Checklists.).

Regarding computer-implementation, Whitacre teaches this functionality, especially as applied in its computer-implemented employee scorecard and dashboard tools (Whitacre, Figs. 1, 3–4, and 14; ¶ 0030, discussing the reporting tool functionality). Applying the known technique of computer implementation to a known device, the root-cause tools, ready for improvement,

would have been obvious to one having ordinary skill in the art at the time of the invention to achieve a predictable result and result in an improved system that produces results more expediently with less effort and thus saves the user significant time and resources. Moreover, merely providing an automatic means, namely a computer and its standard components, operating a computer program embodied on a computer readable medium, to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Whitacre teaches an automated scoring mechanism that generates a scorecard that scores and employee based on their performance (*see e.g.*, Whitacre, Fig. 8, showing Employee A's performance results in the form of scores in categories such as effectiveness and attendance; Fig. 3, Employee Scorecard) but does not explicitly apply it to the root-cause analysis tool in the manner claimed by Applicant. Miller, in the analogous art of employer-based testing, teaches scored questions produced by an automated scoring mechanism, the automated scoring mechanism automatically counting the number of responses in all fields of a question set of the multiple question sets and scoring the question set against a total number of all fields in the question set to produce a numeric value which is an indication of the strength of overall performance for the question set (Miller, ¶ 0247).

It would have been obvious to one of ordinary skill in the art to modify Whitacre to include the teaching of Miller because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding the fact that the fields are required fields, Miller does not explicitly apply its scoring functionality to this feature but does teach the inclusion of mandatory, or required, questions (Miller, ¶¶ 0074, 0244) and is readily capable of tracking just those answers as it has the capability of scoring by category (Miller, ¶ 0122). Therefore, applying the known technique of scoring by category to known category, that is required or mandatory question fields, would have been obvious so as to achieve a predictable result and result in an improved system that is more robust and can more accurately pinpoint the root cause of a problem.

Regarding the score being a strength of responses indication which is an indication of the strength of analysis, Miller does not explicitly discuss its strength of responses or strength of analysis as applied to *the subject matter of the question set*—such as, for example, a recognition that if Applicant answers all the questions about his character in an inconclusive, non-telling manner, the strength of analysis with respect to character is low in evaluating whether character is the root of the candidate's inadequacy; however, if Applicant answered all the questions about his character in a conclusive, negative way, the strength of analysis with respect to character is high in evaluating that character is the root of the candidate's inadequacy. However Miller documents and analyzes responses to all questions in all categories. As such, Miller is readily capable of monitoring quantities and qualities of answers (and non answers) to questions and question categories upon submission of a test (*see e.g.*, ¶ 0122). Furthermore, Official Notice has been taken—and not since adequately traversed by Applicant—that the greater the number of pertinent questions answered, the stronger the result set—this officially noticed fact is thus considered Applicant's admitted prior art. Given Whitacre's root cause analysis where a positive answer to a question strengthens the finding of the root cause of the problem regarding the

subject matter of that question, the disclosure of Miller, and Applicant's admitted prior art, it would have been obvious to one having ordinary skill in the art to track the strength of response as a strength of analysis based on number of responses against a total number of required fields in order to help employers recognize job application issues that are of utmost importance and as such focus on those issues in their candidate-position matching endeavor.

Whitacre in view of Miller further in view of Applicant's admitted prior art does not explicitly teach wherein the project or effort is one of product development, the product development effort being undertaken to produce a tangible product. Nelson teaches this limitation in the analogous art of risk identification in product development (Nelson, Summary of Invention, especially col. 1, lines 40–47; *see also* Figs. 21–22, and 26, for tangibility of product disclosed via destructive tests).

Whitacre in view of Miller further in view of Applicant's admitted prior art does not explicitly teach (1) wherein the assessment is done with respect to a product development effort to produce the tangible product; (2) wherein different specific project roles are identified to provide responses to questions of different questions sets of the multiple question sets; or (3) representing the impact of the respective root cause of trouble on the project development effort.

Nelson teaches (1) (*see* at least col. 6, lines 38–54) (2) (col. 17, lines 65–67 and col. 18, lines 10–23; both product design and process FMDAs can be conducted, each comprising a different project role (design engineers, process engineers); *see also* Fig. 15, laying out the FMDA process; Figs. 3 and 5, laying out a design FMDA applied to a brake actuator, wherein the potential cause of failure, potential effects of failure, and potential failure mode are to be entered and the severity, occurrence, detection, and RFN (Risk Factor Number) are asked for

and responded to by the team of engineers specific to the process or product design.); and (3) (col. 9, line 43—col. 20, line 3, discussing the ranking of severity, occurrence, and detection of undesired events).

It would have been obvious to one of ordinary skill in the art to modify Whitacre in view of Miller further in view of Applicant's admitted prior art to include the teaching of Nelson because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per the limitation—wherein the computer-implemented tool plots each root cause of trouble of the multiple possible root causes of trouble using the produced numeric values in a graph with a first axis representing strength of responses for the respective root causes of trouble and a second axis representing impact of the respective root causes on the product development effort, the graph facilitating assessing the product development effort by facilitating identifying a possible root cause of trouble of the multiple possible root causes of trouble with a high impact on the product development effort and strong responses in support of the presence of the root cause of trouble—none of the cited art explicitly teaches the claimed plotted graph. However, Nelson teaches a computer-implemented tool plots a first variable in a graph with a first axis representing a first variable and a second axis representing a second variable (*see* at least Figs. 10 and 12). As such, it would have been obvious to apply Nelson's graphing technique to the known elements of impact and strength of response as rendered obvious by the cited prior art and rationale provided above so as to achieve a predictable result and result in an

improved system that better pinpoints the most likely cause of a problem.

8. As per claim 2, Whitacre teaches evaluating project management processes employed for the effort by comparison thereof to identified, standard project management processes (Whitacre, ¶ 0088, "c) Does the Team Member know that the performance is less than satisfactory (e.g., feedback given to team member, team member aware of unsatisfactory performance)? If yes, consider the basis for how you know the team member is aware that his performance is less than satisfactory. Else, provide appropriate feedback to the team member. (d) Does the Team Member know what is supposed to be done and when (i.e., objectives and standards been defined and mutually agreed upon and clearly stated)? If yes, how do you know the Team Member knows what is suppose to be done and when? Else, set clear goals, objectives and standards with the Team Member to clarify expectations."), and wherein the tool provides guidance regarding effectiveness of implementation of the project management processes employed for the effort (*id.*; *see also* Whitacre, ¶ 0086). As per product development and computer-implementation, see the rejection of claim 1.

9. As per claim 3, Whitacre teaches evaluating project management work product of the effort and inputting work product assessment to the tool as further evidence of the existence of the one or more root causes of trouble for the product development effort or the effectiveness of implementation of the project management processes employed for the effort Whitacre, (¶ 0088, "a) Is there a performance gap (i.e., basis, difference from target)? If so, what is the performance gap? Else, no further analysis required."). As per product development and computer-implementation, see the rejection of claim 1.

10. As per claim 5, identifying in the tool the specific project personnel roles to answer questions of the multiple question sets (Whitacre, "¶ 0086, "(a) Enlist individuals to help in the root cause analysis. Include individuals that are directly affected by the outcome of the actions to be taken (e.g., Subject Matter Expert, another Team Leader/or an Operations manager"; Whitacre, ¶ 0088, discussing questions given by team leader or other interested individual regarding team members performance and project circumstance). Whitacre does not explicitly teach wherein the question sets also reside in the computer-implemented tool. However, storing project performance management data in a computer implemented tool was old and well known in the art as evidenced at least by Whitacre (Whitacre, ¶ 0030, Fig. 1, ref. 12, Consolidated-Reporting Database).

Because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that

is in the substitution of question sets for the reporting data of Whitacre. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

11. As per claim 6, Whitacre does not explicitly teach wherein the product development effort comprises one of a software development project or a hardware development project. Regarding the type of project, this constitutes nonfunctional descriptive material and should not be given patentable weight. The type of a particular project, without positive functional recitation as to its distinctive use, amounts to mere labeling of data and does not functionally alter the method of assessing a project. See MPEP 2106.01 [R-5]. Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior art. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (*see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, this further purported limitations of claim 6 fails to further limit the invention as claimed.

12. Claims 8–10, 12–13, and 15–17, and 20 recite limitations that stand rejected via the art citations and rationale applied to claims 1–3, 5–6, 1–3, and 6, respectively, as discussed above.

Response to Arguments

13. Applicant's arguments filed 4/22/09 have been fully considered but they are not persuasive.

14. Applicant argues that the cited prior art does not teach "required fields". Applicant's Remarks, 4/22/09, pg. 4–5. In response, Examiner respectfully disagrees. Regarding the fact that the fields are required fields, Miller does not explicitly apply its scoring functionality to this feature but does teach the inclusion of mandatory, or required, questions and is readily capable of tracking just those answers as it has the capability of scoring by category. Therefore, applying the known technique of scoring by category to known category, that is required or mandatory question fields, would have been obvious so as to achieve a predictable result and result in an improved system that is more robust and can more accurately pinpoint the root cause of a problem.

15. The remainder of Applicant's arguments with respect to claims 1–3, 5–6, 8–10, 12–13, 15–17, and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Lange et al., *Potential Failure Mode Effects and Analysis*, Chrysler, Ford, and General Motors, 2001, pg. 1–90 (disclosing numerous failure detection, analysis, and scoring methods in the product development process).

B. Elgabry et al., U.S. Pub. 2002/0138406 (disclosing a risk assessment method for the product development process including the identification and ranking of future impact factors).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Pats whose telephone number is (571)270-1363. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6738. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623